The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ANTONY C. ALIBERTO,
SCOTT M. EVANS, and WILLIAM J. WORTHEN



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Appeal No. 2004-1407
Application No. 10/057,334

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REQUEST FOR REHEARING UNDER 37 C.F.R. § 1.197[1]

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Before METZ, GRON, and HANLON, Administrative Patent Judges.

GRON, Administrative Patent Judge.

Decision on Request for Rehearing

Appellant requests rehearing under 37 C.F.R. § 1.197 of the Decision On Appeal Under 35 U.S.C. § 134, entered July 27, 2004 (Paper No. 11). The request must state with particularity the

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[1] Now 37 CFR § 41.52, effective September 13, 2004. 69 Fed. Reg. 49960 (August 12, 2004).

appellant urges that the Board improperly based its conclusion that a prima facie case of obviousness of the invention of Claim 5 had been established in view of combined prior art on (1) hindsight, and (2) an improper combination of nonanalogous references. We disagree.

"During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). When interpreting claim language, one looks first to the claim language itself and then to the specification. The claimed methods comprise the acts of "advancing a heat exchange catheter device into the patient; circulating coolant through the catheter device . . . and performing [aneurysm (Claim 5) or minimally invasive heart (Claim 8)] surgery . . . while the patient's temperature is below normal body temperature." The Board properly looked to the specification to give meaning to the claim language and determine the broadest reasonable scope and content of the claimed subject matter.

As it did in its brief, Appellant again argues that the teachings of Clifton and Ginsburg are not combinable because Clifton requires profound hypothermia during surgery and Ginsburg cools the body to less severe temperatures during surgery (Paper No. 12, pp. 1-2, bridging para.). We remind appellant that the

claims before us require surgery to be performed "while the patient's temperature is below normal body temperature" (Claims 5 and 8).

We have considered the prior art for all it teaches. Appellant has not. Clifton teaches that the body temperatures of patients may be, and have been, lowered anywhere from moderately to profoundly depending upon the severity and requirements of the surgical procedure to be performed (Clifton, cols 1-3). Moreover, Ginsburg contemplates profoundly cooling the body to temperatures as low as $0^{o}$ C. (Ginsburg, col. 8, l. 45-54). Most importantly, we have compared the prior art teachings to broadly claimed methods wherein a patient's temperature may be lowered to any and all levels below body temperature. Appellant has not.

Appellant's criticisms of the Board's findings that the cited prior art references are all analogous to the claimed subject matter and/or the Board's determinations that the claimed subject matter would have been obvious in view of combined prior art teachings as a whole neither consider the full scope and content of the claimed subject matter nor fairly compare the breadth of that subject matter to all the prior art teaches. Accordingly, appellant's explanations why the Board purportedly misapprehended or overlooked points in its decision are not entirely proper and somewhat meaningless. "[T]he name of the

game is the claim." In re Hiniker, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

Accordingly, appellant's request for rehearing under 37 C.F.R. § 41.52 is DENIED.

ANDREW H. METZ )
Administrative Patent Judge )
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TEDDY S. GRON ) BOARD OF PATENT
Administrative Patent Judge ) APPEALS
) AND
) INTERFERENCES
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)
ADRIENE LEPIANE HANLON )
Administrative Patent Judge )

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